

Appl. No.: 09/890,696
Amendment Dated: August 14, 2006
Reply to Office Action of April 12, 2006

Remarks

This is in response to the Office Action dated April 12, 2006. Claims 11-17 and 20 stand rejected as obvious over *Lerg et al.* ('738 Patent) in view of *Balzer* ('651 Patent) and *Bergmann et al.* ('040 Patent) and in further view of *Ansmann et al.* (EP '559), *Scholz et al.* (DE '733) and Applicants' admission. The rejection is again respectfully traversed.

Not only with respect to this rejection, but as well as to all other rejections in the Office Action, the Examiner has basically cast the patentability issue and has buttressed the rejections on the proposition that it would simply be obvious to dilute the *Lerg et al.* composition and form it into a microemulsion to arrive at Applicants' claimed composition. In essence, the Examiner has taken the position that the express teachings of *Lerg et al.* can simply be ignored and the Examiner's judgment substituted therefor. In pertinent part, Applicants' composition and the *Lerg et al.* composition are set forth as follows:

	Applicants' Composition (In Part)	<i>Lerg et al.</i> Composition (In Part)
Oil Component	0.1 to 20 % by weight	30 to 45 % by weight
Water Content	20 to 95 % by weight	"At most 3.5 % weight"
Microemulsion	Yes	No
Optically Transparent	Yes	No

Despite those glaring differences between Applicants' composition and the *Lerg et al.* composition, the Examiner tenaciously clings to the erroneous conclusion that, *inter alia*, Applicants' composition is still nothing more than a diluted form of *Lerg et al.* The Examiner's attempted combination of *Lerg et al.* with the secondary references to *Balzer*, *Bergmann et al.*, *Ansmann et al.* and Applicants' admission, do absolutely nothing to address the fact that none of those references cure the infirmities of *Lerg et al.* vis-à-vis teaching or suggesting anything remotely

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resembling Applicants' composition as set forth above and compared with the *Lerg et al.* composition.

The thrust of the Examiner's position is that a person of ordinary skill in the art would have been motivated to dilute the composition of *Lerg et al.* with water and formulate the composition into microemulsion form simply because fatty acid ether sulphate alkanolammonium salts, or fatty alcohol sulphate alkanolammonium salts are known to be useful as emulsifiers and particularly useful in microemulsion cosmetic compositions. In response to this position, Applicant rhetorically poses the question "where is the motivation?" It is beyond peradventure that the law is that the claimed invention cannot be said to have been obvious absent some reason or motivation given in the prior art why someone would have been prompted to combine the teaching of the reference *In re Regel* 188 U.S.P.Q. 136; *In re Bond* 15 U.S.P.Q.2d 1566 (*per curiam*). Applicant recognizes that the motivation need not come from the prior art but may come from other sources as, for example, economic factors. However, whatever the source, the suggestion or motivation must be present regardless of how "minor" or "trivial" the differences are between the claimed invention and the prior art. *In Northern Telcom, Inc. v. Datapoint Corp.*, 15 U.S.P.Q.2d 1321 (*per curiam*). Wherein no reasonable justification exists for the combination, obviousness has not been established *In re Chu* 36 U.S.P.Q.2d 1089; *In re Geiger* 2 U.S.P.Q.2d 1276 "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combinations"; *In Re Lintner* 173 U.S.P.Q. 560. Lastly, the motivation must come from someone other than the Applicant or patentee *In re Fritch* 23 U.S.P.Q.2d 1780.

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It is the position of the Examiner, as stated in paragraph 7 of the Office Action, that this “motivation” to dilute the composition of *Lerg et al.* exists merely because fatty alcohol ether sulphate alkanolammonium salts are fatty alcohol sulphate alkanolammonium salts are known to be useful as emulsifiers. That position, with all due respect, is illogical. Simply because a given material can be used to form microemulsions in some compositions provides no motivation to the skilled artisan to dilute a given composition and in this case even dramatically change the oil and water content.

The Examiner has pointed to column 2, lines 1-5, apparently for support for this dilution theory. The cited lines simply teach that a disadvantage of some prior art bath preparations is that they are present in dilute form because a bath tub can hold up to several hundred liters of water and to accommodate this the bath preparation must be formulated by employing large amounts of oil in the bath preparation to be used. How does that teaching suggest to one of skill in the art, that the *Lerg et al.* composition could be modified to dramatically increase the water content and dramatically lower the oil content?

The Examiner has overlooked what the *Lerg et al.* reference considers the invention of the *Lerg et al.* patent, i.e., “a markedly lower oil content which is still able to refat the skin. If indeed that is “surprising and unforeseeable” as stated by *Lerg* in column 2, lines 24 *et seq.*, then Applicants’ composition is even more surprising and more unforeseeable since Applicant has even far less oil in its composition than *Lerg et al.*..

The Examiner continues to point to the fact that Applicant’s “diluted composition” even though it is inferior because of its “inconvenience” is nonetheless deemed to be obvious in view of

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and not patentably distinct from the concentrated form. To begin with, the Examiner in focusing simply on “dilute versus concentrated” has simply assumed without any support, that Applicants’ composition is inferior presumably because it does not have the oil content of *Lerg et al.* Applicant respectfully requests the Examiner to point out how Applicants’ composition is inferior to that of *Lerg et al.* simply because it has a lower oil content. Furthermore, and as expressly recognized by the Examiner, *Lerg et al.* does not teach a composition with substantial amounts of water or a composition in the form of a microemulsion. Lastly, as now amended, the claims call for the microemulsion to be optically transparent. There is absolutely no suggestion or teaching in *Lerg et al.* to form an optically transparent microemulsion. Thus, Applicants’ claims are not directed merely to a microemulsion but to an optically transparent microemulsion.

In *Lerg et al.* the best that can be said is that with the proper emulsifier *Lerg* may form a non-transparent emulsion but not an optically transparent microemulsion.

Furthermore, even assuming that the *Lerg* composition was diluted, there is absolutely no reason to believe that an optically transparent microemulsion would be formed. An everyday example of this is the fact that when an emulsion such as milk is diluted, no transparent microemulsion is formed. Simply stated, even when a microemulsion is diluted, it may still remain a non-transparent emulsion.

With respect to *Balzer*, it is true that the reference does mention alkyl sulphates or alkyl ether sulphates in a long list of possible co-emulsifiers. However, nowhere does *Balzer* disclose the compound (A) with R⁴ isopropyl as per Applicants’ claims.

Furthermore, *Balzer* does not teach the presence of mono- or polyvalent C₂-C₂₄ alcohols.

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Alkylpolyglycosides (APG) are not “polyvalent C₂C₂₄ alcohols” as APG’s fall under category (E), further surfactants as per Claim 14 of the present application.

With respect to Claim 20, that claim includes the limitation “wherein no compound falls under two categories at the same time.” APG cannot fall under (D) and (E) at the same time and can clearly only be (D) only.

The microemulsions of *Balzer* require the presence of at least 80 wt. % alkylpolyglycosides (APG). Such a composition does not remotely resemble Claim 11 and in this regard note that components (A) to (D) of Claim 1 add up to 20.7 wt. %. Firstly, this requirement of 80 wt. % APG is contradictory to the teaching of *Lerg* that requires at least 30 % by weight of an oil component, and nowhere in *Lerg* is APG suggested as a further surfactant. It is also worthy to note that *Lerg et al.* disclose a further surfactant (e) such as an APG to be present up to an amount of 5 wt. % (see column 6, lines 1-15). Also, APG is not suggested by *Lerg et al.* as a further surfactant.

Not only does *Balzer* fail to cure the infirmities of *Lerg et al.* vis-à-vis Applicant claims, it actually would lead the skilled artisan away from Applicants’ claims. In this regard, the following points must be considered:

- *Balzer* requires at least 80 % by weight APG based on the sum of APG and co-surfactant
- *Balzer* may select a different co-surfactant from the many co-surfactants mentioned in column 3
- *Balzer* will not use mono- or polyvalent C₂C₂₄ alcohols.

With respect to *Bergmann et al.* that reference is very similar to *Balzer* with the exception that *Bergmann et al.* mentions triethanolamine salts of lauryl sulphate and lauryl ether sulphate

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among other possible surfactants (column 18, line 63-64). However, triethanolamine salts are not called for in either Claims 11 or 20 of Applicants' application.

Furthermore, such compounds do not form a microemulsion and are only part of a composition comprising a cleansing surfactant to which a microemulsion may be added (column 18, line 34-46). Additionally, *Bergmann* does not disclose whether an oil component in the amount specified in Claim 11 is part of the composition and polyols are mentioned as a further optional ingredient of the emulsion of *Bergmann* but not with reference to component (A) of Claim 1. It is simply impossible to combine the teachings of *Lerg et al.* with *Bergmann* as *Bergmann* requires significant amounts of water to be present (column 18, lines 5-6). That teaching is directly contrary to a critical limitation of *Lerg*, i.e., that the composition contains "a water content of at most 3.5 % by weight." See column 2, lines 42-43.

It is respectfully submitted that the combination of *Lerg et al.* with the secondary references does not make out a *prima facie* case of obviousness.

Claims 11-17 and 20 stand rejected as obvious over *Hermann et al.* in view of *Balzer* and *Bergmann* and in further view of *Ansmann*. This rejection is likewise respectfully traversed. As recognized by the Examiner, *Hermann* suffers from the same infirmities of *Lerg* and Applicants' remarks above with respect to the failure of the reference to make out a *prima facie* case of obviousness are equally applicable here. Additionally, and for the same reasons pointed out above, the secondary references cannot be combined with *Hermann* in any logical manner to arrive at Applicants' claimed composition without resort to Applicants' disclosure.

Turning specifically to *Hermann*, that reference essentially mimics *Lerg et al.* in that it is

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critical that the amount of water be kept relatively low, i.e., not in excess of 15% by weight.

Hermann thus teaches an oil component being present in an amount of 20-60% by weight and

Hermann does not teach a microemulsion.

Hermann et al. and *Lerg et al.* are identical in teaching away from Applicant's relatively high amount of water and relatively low amount of oil. Furthermore, neither of the references teach C₂ to C₃ hydroxyalkyl ammonium salts and require significant amounts of other surfactants and do not teach or suggest optically transparent microemulsions.

The *Ansmann* reference does nothing to cure the infirmities of *Hermann*. *Ansmann* teaches a composition comprising

- (A) 10-50 wt. % C₁₆-C₂₂ alkyl-oligo-glucoside
- (B) 50-90 wt. % C₁₆-C₂₂ fatty alcohol
- (C) 0.1-10 wt. % alkyl and/or alkenyl (ether) sulphate

Ansmann et al. does not teach isopropanol ammonium salts of alkenyl (ether) sulphates and transparent microemulsions are not even mentioned.

DE 35 34 733 (*Scholz et al.*) disclose aqueous surfactant preparations which foam will and contain 0.05 to 3% by weight of water-insoluble oils, fats or waxes which have been solubilized to give a clear solution and are prepared by mixing

- (A) oil, fat or wax
- (B) a non-ionic polyethoxylated emulsifier, the mixture being heated where appropriate above its melting point
- (C) adding an aqueous solution which has been heated to the same temperature of an

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anionic surfactant and

(D) where appropriate, including amphoteric and/or zwitterionic surfactants and/or amine oxide surfactants.

Suitable and preferred polyethyoxylated emulsifiers and fatty acids (C₈-C₁₈ mono- and diesters of adducts of 4 to 20 mol of ethylene oxide and glycerol or adducts of 4 to 20 mol of ethylene oxide and fatty acid C₈-C₁₈, mono-, di- and triglycerides. *Scholtz et al.* does teach the use of a number of anionic surfactants, but there is no teaching or mention of isopropanol alkanol ammonium salts as claimed by Applicant.

With respect to the Examiner's remarks in paragraphs 13-15 of the Office Action, the Examiner argues that the references cannot be attacked individually since the rejection is based on a combination of references. While Applicant would not argue with that general proposition of the law, that rule of law has no place here. In particular, as to the Examiner's remarks that the primary reference to *Lerg* teaches essentially an identical composition except for the concentration (the amount of water) and the droplet science (microemulsion), Applicant would point out that *Lerg et al.* is also deficient in teaching the amount of oil claimed by Applicant or an optically transparent microemulsion. Further the Examiner argues that the secondary references provide teachings on how to form microemulsions in the presence of other surfactants as allegedly suggested by *Lerg et al.* The fact of the matter is that none of the references teach optically transparent microemulsions meaning that *Lerg* is deficient in (a) the amount of water, (b) the amount of oil, (c) the presence of optically transparent microemulsions. None of those infirmities are cured by resort to the secondary reference and Applicants' extensive arguments regarding the teachings of the secondary references is

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to show their deficiencies vis-à-vis curing the deficiencies of *Lerg et al.*

With respect to the Examiner's argument in paragraph 14 of the Office Action regarding hindsight reasoning, the Examiner takes the position that hindsight reasoning is acceptable as long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from the Applicant's disclosure. The fact of the matter is, as pointed out extensively above, the secondary references do not cure any of the infirmities of *Lerg et al.* Indeed, the Examiner has attempted to cure those infirmities by casting the issue as being one of "dilution" rather than attempting to show that the secondary references actually overcome the deficiencies of *Lerg et al.* Other than the Examiner's opinion that the issue of patentability *vel non* is one of dilution, in point of fact, save for resorting to Applicants' disclosure or adapting the Examiner's position that the issue is nothing more than one of dilution, there is no way to overcome the deficiencies of *Lerg*.

Lastly with respect to paragraph 15 of the Office Action and Applicants' argument regarding "obvious to try" Applicant has elaborated at great length the differences between *Lerg et al.* as well as the secondary references. Indeed, since the present claims now call for the composition to be an optically transparent microemulsion and since neither *Lerg et al.* or *Hermann et al.* disclose such, the only possible way of arriving at Applicants' claimed composition is to "try" to modify *Lerg* in the hopes that one will obtain an optically transparent microemulsion having Applicants' claimed amount of water and oil. It is respectfully submitted that with that position, the Examiner is asserting an obvious to try standard in an attempt to overcome the deficiencies of the references.



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In view of the foregoing amendments and remarks, it is respectfully submitted that all claims are in condition for allowance which is hereby earnestly solicited and respectfully requested.

Respectfully submitted,

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